

REMARKS

Formalities

The examiner's characterization of Matzig U.S. 2004/0064413 as a reference having a 35 U.S.C. 102(e) effective date with regard to the claims of this application is incorrect. The examiner is referred to §706.02(f)(1) MPEP clearly showing that a U.S. patent application that is the national stage of an international application filed on or after November 29, 2000 has no §102(e) date if the international application was not filed in the English language. In this case, U.S. 2004/0064413 A1 is a U.S. national stage application of PCT/EP01/15017 published as WO 02/50784 A2 on June 27, 2002 in the German language. Because the PCT application was not filed in the English language, U.S. 2004/0064413 A1 has no effective §102(e) date.

The examiner more properly should have relied on WO 02/50784 A2 under 35 U.S.C. 102(a) as of its publication date June 27, 2002. In the following arguments, reference will be made to U.S. 2004/0064413 as "Matzig" as the equivalent of WO 02/50784.

Claim Amendments

The claims have been amended to remove commas from certain passages of the claims to avoid possible misinterpretation of the intended meaning of the claims. The amendments are neither broadening nor narrowing, but merely remove commas to provide smoother continuity of the recited language.

Arguments

It is respectfully submitted that the examiner has misconstrued the disclosure and teaching of Matzig such that the rejection of the claims presented in this application under 35 U.S.C. §102 is improper.

Matzig fails to disclose that the bank notes recognized as not fit for circulation are at least partially transported into a storage device not accessible by the operator during an ongoing money transaction.

On the contrary, a careful reading of Matzig (see paragraph [0039]) reveals that all the bank notes that are not recognized by the checking device 10 as suitable for circulation are

transported via the diverter to the output compartment 4, that in this case serves as a reject compartment accessible to the machine operator.

Paragraph [0039] also indicates that all bank notes recognized as false or suspected of being forgeries can be transported into a separate [inaccessible] storage compartment 14 provided in the cassette 15.

Accordingly, Matzig only teaches that bank notes not fit for circulation are transported back to the output compartment accessible by the operator, while bank notes that are false or forgeries are transported to the storage compartment that is not accessible by the operator.

The examiner will recognize that bills identified as not fit for circulation are not the same as bills that are unrecognized, false or forgeries. The latter cannot be recognized as bank notes, while the former are recognized as authentic bank notes.

Claim 1 recites that the bank notes, after being checked for fitness for circulation are at least partially transported into a storage pocket not accessible by the operator during the ongoing money transaction. In accordance with claim 1, bank notes that are recognized as true bank notes but yet are not fit for continued circulation, are at least partially removed from circulation by placing them in a compartment that is not accessible by the operator. This is entirely contrary to the teachings and disclosure of Matzig.

Because Matzig lacks an element recited in the claims, a rejection of the claims under 35 U.S.C. 102 is not legally proper and should be withdrawn.

The examiner is reminded that claim 1 recites that the bank notes recognized as not fit for circulation are not accessible by the operator during the ongoing money transaction. Accordingly, any prior art system that enables the operator to access notes not fit for circulation in a money deposit transaction process will not establish lack of novelty or obviousness of the claimed subject matter. As an example, U.S. 4,744,468 (Goai et al.), while disclosing that “damaged” bills may be transported to a cassette, nevertheless discloses in accordance with steps 419A/419B or steps 421A/421B (see column 12, lines 8-21) an operator may select whether or not to deposit the “damages” bills in a cassette or return them outside the machine.

The examiner will recognize that the process disclosed in Goai et al. does not anticipate nor render obvious the process recited in claim 1 of this application which

necessitates bills not fit for circulation be at least partially transported into a storage pocket not accessible by the operator during the ongoing money transaction.

With regard to independent claim 8, this claim recites a control unit arranged to actuate the transport system in such a way that bank notes not fit for circulation at least partially are transported into the not accessible storage pocket. As noted, previously, all of the bank notes not fit for circulation in accordance with Matzig must be discharged into the output compartment 4 (paragraph [0039]). There is no disclosure contained in Matzig or even the remotest suggestion that bank notes not fit for circulation can be transported to a compartment that is not accessible by the operator.

In the last paragraph of page 3 of the Action, the examiner comments that Matzig discloses a control unit (17) "arranged to actuate the transport system in such a way that bank notes not fit for circulation at least partially are transported into the not accessible storage pocket, and bank notes fit for circulation at least partially are transported into the freely accessible storage pocket, citing paragraphs 29-32 of Matzig.

The examiner is requested to substantiate this statement, as the language in the cited paragraphs 29-32 does not support the examiner's conclusion. Bank notes not fit for circulation, in accordance with Matzig, are always circulated to the output compartment 4 (see paragraph [0039]). The output compartment 4, of course, is identified as a "reject compartment".

Accordingly, it is not seen in Matzig where the transport system is controlled in such a way that bank notes not fit for circulation are at least partially transported into the non-accessible storage pocket.

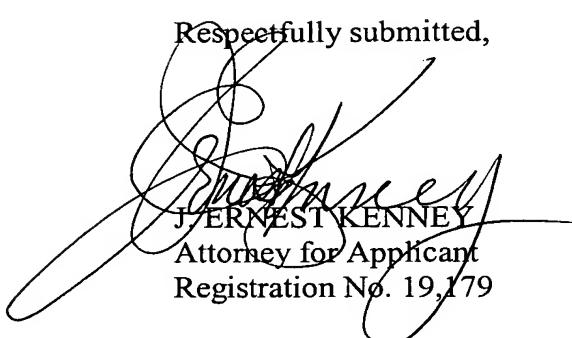
The present invention, on the other hand, is directed to a system wherein the bank notes not fit for circulation are at least partially transported to a storage pocket not accessible by the operator. This is contrary to the teachings of Matzig and it is respectfully submitted that, for this reason, the rejection of claims 1-13 under 35 U.S.C. 102(e) as being anticipated by Matzig is not legally supportable and that withdrawal of the rejection is appreciated.

In conclusion, it is respectfully submitted that the claims under consideration in this application define novel subject matter not anticipated by the cited prior art of record, which fails to disclose or suggest transporting at least parts of bank notes not recognized as not fit for circulation into a storage pocket that is not accessible by the operator during the ongoing

money transaction. Accordingly, allowance of the claims is in order and the passage of the application to issue is requested.

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Date: April 16, 2008

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